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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/198,067	11/28/1998	MICHAEL PRINCE	1400.9800940	2061

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EXAMINER

NGUYEN, STEVEN H D

ART UNIT PAPER NUMBER

2665

DATE MAILED: 02/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/198,067

Applicant(s)

PRINCE ET AL.

Examiner

Steven HD Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 11,12 and 20-21 is/are allowed.
- 6) ☒ Claim(s) 1,5-10,13 and 17-19 is/are rejected.
- 7) ☒ Claim(s) 2-4 and 14-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments with respect to claims 1-10 and 13-19 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1, 5-10, 13 and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Han (USP 6222844).

Regarding claims 1, 9, 13 and 18, Han discloses (Fig 1-10 and col. 1, lines 8 to col. 14, lines 65) an adaptive service interworking (Fig 1, Ref 3) comprising the steps of in response to receive a setup message for identifying a receiving party which is coupled to the endpoint switch from a sending party, obtaining connection information of an end point network switch (Fig 8,

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Ref S210 receives a PVC connection between the source and destination); interpreting the connection information to determine whether the endpoint switch is capable of supporting a transparent link between the sending and receiving party and when the endpoint switch supports the transparent link, supporting the transparent link between the receiving and sending party (Fig 8, Ref 205-207, the interworking unit determines if the destination side support a transparent or translation mode; if the destination side support a transparent mode, the interworking unit will established a transparent link; it is inherently discloses in FR/ATM interworking unit based on the agreement in FRF.8 based on the upper layer protocol which is registered in the database is transparent mode).

Regarding claims 5-6, Han discloses the connection information comprising at least one of a data transport protocol and a network switch type (Fig 3c, Ref OMCM is a database which stores a network switch type for supporting transparent link and ATM protocol such as D\_ULPT) wherein the network switch type can be used to process the enhanced traffic description (Fig 3c, traffic description such PCR).

Regarding claim 7, Han discloses the receiving party is a user (Fig 5, subscriber).

Regarding claims 8 and 17, Han inherently discloses the service interworking being default to translation if the endpoint network does not support transparent link.

Regarding claims 10 and 19, Han inherently disclose extracting an enhanced traffic descriptor which identifies the data transport protocol from the setup message to determine if the receiving party supports the data transport protocol of sending party in order to establish a transparent link between the users (the interworking unit must extract protocol identifier in order to recognize if the destination interworking unit supports this protocol or not).

***Allowable Subject Matter***

4. Claims 11-12 and 20-21 are allowed.
5. Claims 2-4 and 14-16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Fontenot (USP 6463477) discloses a method and apparatus for detecting of presence of multiprotocol encapsulation in data packet in order to recognize if data packet is in transparent or translation mode.

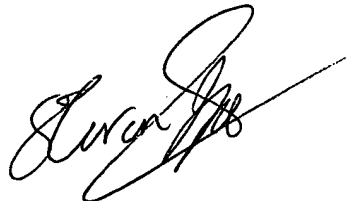
Doug (FRF.8) discloses an agreement between the providers establishes a connection in transparent or translation mode between the users.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (703) 308-8848. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (703) 308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

A handwritten signature in black ink, appearing to read "Steven HD Nguyen", with a long, sweeping horizontal line extending to the right.

Steven HD Nguyen  
Primary Examiner  
Art Unit 2665  
February 22, 2003